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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
7251/78746

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Wachtfogel et al.Art Unit
2623Examiner
Hai V. TRAN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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21 September 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Reasons That Pre-Appeal Brief Review is Requested

The pending Final Office Action rejected all remaining claims. Applicants appeal the rejections of independent claim 132 and its dependent claims 134-36, and will cancel the other claims without prejudice prior to submitting an appeal brief or if the rejections of claims 132 and 134-36 are withdrawn.

A. Prior Art Rejection of Claims 132, 134 and 135

The Final Office Action rejected claims 132, 134 and 135 as being rendered obvious by Alexander in view of Akiba. On page 10, it conceded that Alexander does not disclose the limitation of independent claim 132 that

for at least one of said commercials, said dealing with said commercials comprises dealing with said one commercial by presenting alternative shortened versions of other commercials in response to a user request to view said one commercial in a fast-forward or fast-backward mode.

1. Akiba Does Not Disclose the Missing Limitation.

Akiba does not disclose presenting shortened versions of **other** commercials as required by the claims. In claim 132, the claimed "**other** commercials" are definitely not the "at least one of said commercials" that the user requests to view in fast forward/backward.

The Final Office Action suggested that when the Akiba user requests fast forward for one commercial, that there is a series of commercials coming and that there will be shortened versions of all of them. The Final Office Action characterized this possibility as presenting shortened versions of other commercials. However, Akiba only discloses a fast version of whatever was already there. Assuming *arguendo* there were a second fast commercial (Akiba does not disclose a second fast commercial), that second fast commercial would **not** be in response to an Akiba user request to view the first commercial in fast forward. It would be in response to the user continuing in fast forward for a second commercial that would have been presented anyway (albeit more slowly) absent the fast forward request. That second commercial would be one of the "at least one of said commercials" for which the user has requested fast forward. As part of the claimed "at least one of said commercials," it could not be a claimed "other" commercial.

The teaching of Akiba pertains to all video and not to commercials in particular. It teaches some blending from screen to screen to ease eye strain apparently caused by skipping so many screens in a fast forward mode. (Akiba Abstract; 4:32-37). Akiba also discloses a scheme by which the sampling of screens based on a predetermined interval is delayed and a commercial is skipped entirely, if the commercial is too short relative to the sampling interval. (Akiba 4:61-64; 12:44 – 14:5; Figs. 10 and 11).

Akiba does not teach shortened commercials *per se*, and certainly not short versions of other commercials (i.e., different than the one for which the user requests fast forward). At most, Akiba discloses a fast version of the same commercial for which the user requests fast forward. For purposes of claim 132, Akiba is effectively no different than any fast forward presentation.

Therefore, the combination of Alexander and Akiba does not render obvious claim 132 or its dependent claims.

2. There is No Reason to Combine Akiba and Alexander.

Akiba is about fast forward/backward in general. As discussed above, its subsidiary discussion about commercials appears to disclose skipping them when they are too short and would interfere with Akiba's purpose of easing eye strain in fast forward/backward. Akiba does not address a user request to view a commercial in particular in fast forward/backward, or how to deal with it. To the extent that Alexander discloses dealing with commercials, it also does not teach about dealing with user requests to view a commercial in fast forward/backward. Page 9 of the Final Office Action conceded "Alexander does not clearly disclose decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action." Therefore, neither of the two references addresses the subject of claim 132. There cannot be any justification for combining two references in connection with claim 132, when neither of those references addresses the subject of the claim.

Therefore, the combination of Alexander and Akiba do not render obvious claim 132 or its dependent claims.

3. *Akiba Does Not Disclose Prepared Shortened Versions.*

Dependent claim 134 requires the shortened versions of other commercials to comprise “prepared” meaningful shortened versions. As discussed above, Akiba does not disclose the presentation of **other** commercials as used in the claims. Furthermore, Akiba’s fast versions are not prepared commercials. In Akiba, “the data processor 11 reads out the recorded data from the recording medium 5 at a predetermined interval corresponding to the reproduction speed.” (Akiba, 7:1-3). There is no suggestion of preparing a short commercial that still will be meaningful. Rather, there is merely an automatic selection of screens based on a predetermined interval, without any preparation and without any consideration of whether an intended message will be conveyed.

Alexander also does not discuss shortened commercials, and there is no justification for combining the two references when neither addresses the subject of claim 134.

Therefore, the combination of Alexander and Akiba does not render obvious claim 134.

B. Indefiniteness Rejection of Claim 135

The Final Office Action rejected dependent claim 135 as being indefinite because of the term “approximately,” in the claim limitation that the shortened version has a duration of approximately three seconds. While there may be circumstances when greater precision is necessary to understand the scope of a claim, the Final Office Action did not explain why that would necessarily be so with respect to claim 135. The use in a claim of the word “approximately” or “about” does not necessarily render the claim indefinite. *See e.g. W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 316 (Fed. Cir. 1983) (“The use of ‘stretching … at a rate exceeding about 10% per second’ in the claims is not indefinite.”); MPEP §2173.05(b)A. The scope of claim 135 can be determined as easily as was the case in *Gore*, where the Federal Circuit said “[i]nfringement is clearly assessable through use of a stopwatch.” 220 U.S.P.Q. at 316. “‘About’ is not broad or arbitrary but rather is a flexible term with a meaning similar to ‘approximately.’” *Syntex (U.S.A.) Inc. v. Paragon Optical Inc.*, 7 U.S.P.Q.2d 1001, 1038 (D.Ariz. 1987). “The descriptive word ‘about’ is not indefinite.... Rather, the term is clear but flexible and is deemed to be similar in meaning to terms such as

‘approximately’ or ‘nearly.’” *Ex parte Eastwood*, 163 U.S.P.Q. 316, 317 (Pat.Off.Bd.App. 1968). “As a matter of law, the term ‘about’ is a clear warning that exactitude is not claimed but rather a contemplated variation.” *Kolene Corp. v. Motor City Metal Treating, Inc.*, 163 U.S.P.Q. 214, 220 (E.D.Mich. 1969), *aff’d*, 169 U.S.P.Q. 77 (6th Cir. 1971). Similarly, the limitation that the shortened version has a duration of approximately three seconds is an indication that greater precision is not required by claim 135, and that limitation does not render the claim indefinite.

C. Insufficient Written Description Rejection of Claim 136

The Final Office Action rejected claim 136 as failing to comply with the enablement requirement, asserting that “exactly three seconds” (in the claim limitation that the shortened version has a duration of exactly three seconds) was not described sufficiently in the specification to convey to one skilled in the art that the inventors possessed the claimed invention. Applicants assume that the Final Office Action meant the written description requirement rather than the enablement requirement, as the Final Office Action did not suggest that one of skill in the art could not figure out how to practice claim 136.

Page 32 of applicants’ specification states, “[p]referably, each shortened version of a full commercial may last about 3 seconds....” Applicants submit that “about 3 seconds” demonstrates that the inventors had possession of the claimed “exactly three seconds,” and that the circumstances are at least as persuasive as those in *In re Wertheim*, 191 U.S.P.Q. 90 (C.C.P.A. 1976) (claiming a range of 35-60% and describing a range of 25-60%).

[T]he question is whether, on the facts, the PTO has presented sufficient reason to doubt that the broader described range also describes the somewhat narrower claimed range. We note that there is no evidence, and the PTO does not contend otherwise, that there is in fact any distinction, in terms of the operability of appellants’ process or of the achieving of any desired result, between the claimed ...limit... and that disclosed....

Id. at 98. In the context of claim 136, there is no distinction in terms of operability or of achieving a desired result between about three seconds and exactly three seconds. In *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 227 U.S.P.Q. 177 (Fed. Cir. 1985), the Federal Circuit listed some factors that might support an argument that a claimed range had to

correspond exactly with a described range. Those factors included: unpredictable nature of the art, failure to distinguish one process from another, addition of a critical limitation, failure to define a critical term, and use of a list that did not contain the claimed substance. *Id.* at 179. None of these factors apply to the sufficiency of the support for claim 136 in applicants' written description. The Final Office Action did not present any reason to doubt that the inventors also possessed "exactly three seconds" when they described "about three seconds." This demonstrates that the written description requirement is satisfied for claim 136.